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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,692	03/27/2006	Pascale Lacan	ESSR:111US/10603706	7189
32425	7590	07/25/2011		
FULBRIGHT & JAWORSKI L.L.P. 98 SAN JACINTO BLVD. SUITE 1100 AUSTIN, TX 78701			EXAMINER ROBINSON, ELIZABETH A	
			ART UNIT 1787	PAPER NUMBER
			NOTIFICATION DATE 07/25/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

aopatent@fulbright.com

Office Action Summary	Application No.		Applicant(s)	
	10/573,692		LACAN ET AL.	
	Examiner		Art Unit	
	Elizabeth A. Robinson		1787	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-28,30-34,36,37,39-44 and 47 is/are pending in the application.
- 4a) Of the above claim(s) 23,24 and 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-22,25-28,30-34,36,37,39-43 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5-6-2011</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 19-22, 25-28, 30-34, 36, 37, 39-43 and 47 are currently being examined.

Claim Rejections - 35 USC § 103

Claims 19-22, 25-28, 30-34, 36, 37, 39-43 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conte et al. (WO 03/057641) in view of Spector et al. (US 5,883,169).

Regarding claims 19-22, 25, 26, 30 and 47, Conte (Page 3, line 29 through Page 4, line 6) teaches an ophthalmic lens comprising a temporary protective layer. The temporary protective layer can be formed from MgF_2 (Page 6, lines 16-24). The temporary protective layer can be removed by dry wiping (Page 10, lines 25-29). Conte (Page 6, lines 1 and 2) teaches that the protective layer is preferably continuous. Further as shown in Example 1, the entire lens surface of both the convex and concave sides is coated with the protective layer. Conte (Page 6, lines 16-19) teaches that the protective layer is coated on a hydrophobic and/or oleophobic surface coating.

Conte does not teach coating the protective layer with a peelable film.

Spector (Column 8, lines 33-62) teaches a removable film that can be used on any plastic lens and can provide abrasion protection to the lens during shipment and storage. The film is not crosslinked to the lens surface (Column 2, lines 30-36) and can

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generate static charge when peeled (Column 7, lines 35-46). Thus, the adhesion has some degree of electrostatic adhesion.

It would be obvious to one of ordinary skill in the art to add the abrasion protection film of Spector, to the treated lens of Conte, in order to protect the lens surfaces from abrasion during shipment and storage of the lens. The film would protect the whole surfaces of the lens and would cover the center of the lens.

Since the layer of Spector would be formed when coated and dried and would be formed prior to peeling, the layer can be considered to be a preformed layer, since there is no time claimed that the forming step must occur before. Further, the preforming is a process limitation in a product claim. The patentability of a product is independent of how it was made. *Ex parte Jungfer* 18 USPQ 1796, 1800 (BPAI 1991); *Brystol-Myers Co. v. U.S. International Trade Commission* 15 USPQ 2d 1258 (Fed. Cir. 1989). The burden is on applicants to show product differences in product by process claims. *In re Thorpe* 227 USPQ 964 (Fed. Cir. 1985); *In re Best* 195 USPQ 430 (CCPA 1977).

Regarding claim 27, Conte (Page 6, lines 3-5) teaches that the inorganic (mineral) protective layer has a preferable thickness of 5 to 200 nm.

Regarding claim 28, Conte (Page 8, lines 31-34) teaches that the protective layer has a surface energy of at least 15 mJoules/m².

Regarding claim 31, Conte (Page 6, lines 32 and 33) teaches that the temporary protective layer can have multiple layers.

Regarding claim 32, Conte (Page 7, lines 20-22) teaches that the protective layer can be formed by vapor phase deposition.

Regarding claims 33, 34 and 36, Spector (Column 7, lines 14-34) teaches that the film can be formed from a vinyl chloride copolymer with flexibility that can comprise about 20 to about 30% by weight of a plasticizer.

Regarding claim 37, Spector (Column 8, lines 8-15) teaches that the film preferably has a thickness of about 8 to 50 microns, but that a thicker film will afford greater abrasion resistance.

Conte in view of Spector does not teach a thickness of 100 to 200 microns.

However, since the instant specification is silent to unexpected results, the thickness of 100 to 200 microns is not considered to confer patentability to the claims. As abrasion resistance is a variable that can be modified, among others, by adjusting the thickness of the layer, the precise thickness would have been considered a result effective variable by one having ordinary skill in the art at the time the invention was made. As such, without showing unexpected results, the claimed thickness cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine experimentation, the thickness of the film of Spector, that protects the lens of Conte, to obtain the desired abrasion resistance (In re Boesch, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (In re Aller, 105 USPQ 223).

Regarding claims 39 and 40, Conte (Page 4, lines 29-34) teaches that the hydrophobic and/or oleophobic surface coating preferable has a surface energy lower than 12 mJoules/m².

Regarding claims 41 and 42, Conte (Page 5, lines 17-22) teaches that the hydrophobic and/or oleophobic surface coating preferably has a thickness from 2 to 5 nm.

Regarding claim 43, Conte (Page 4, line 25-28) teaches that the hydrophobic and/or oleophobic surface coating is generally applied to lenses comprising an antireflecting coating.

Response to Arguments

Applicant's arguments filed May 6, 2011 have been fully considered but they are not persuasive.

Applicant argues that the film of Spector et al. (US 5,883,169) is not electrostatically adhering to the surface of the lens and that curing to the lens surface provides the adhesion. However, the film of Spector is not crosslinked to the lens surface (Column 2, lines 30-36) and can generate static charge when peeled (Column 7, lines 35-46). Thus, the adhesion has some degree of electrostatic adhesion.

Applicant argues that the film of Spector is not preformed. However, since the layer of Spector would be formed when coated and dried and would be formed prior to peeling, the layer can be considered to be a preformed layer, since there is no time claimed that the forming step must occur before. Further, the preforming is a process

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limitation in a product claim. The patentability of a product is independent of how it was made.

Applicant argues that one of ordinary skill in the art would expect the protective coating of Conte et al. (WO 03/057641) would be removed when the Spector film was removed. However, Applicant's did not provide any data to show that the removal of the film of Spector would damage the coating of Conte, but only provided conclusionary statements that this was the case.

Due to amendments to the claims, the rejections over Ohlin (US 5,792,537) in view of Hage (US 2004/0087680) and those further in view of Mascarenhas et al. (US 5,888,615) and the rejections over Conte et al. (WO 03/057641) in view of Lipman (US 5,451,281) are withdrawn.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Robinson whose telephone number is (571)272-7129. The examiner can normally be reached on Monday- Friday 8 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. A. R./
Elizabeth Robinson
Examiner, Art Unit 1787

July 11, 2011

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1787